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Section II: REMARKS

It is respectfully requested that the changes as noted above in Section I be made to the present application.

In the above referenced Office Action, which was mailed on 5/6/2004, claims 1-2 and 6-16 were rejected under 35 USC 102(e) as being anticipated by Yohanan. In the Office Action, Yohanan was identified as "(US 6,211,871)" and claim 5 was not included in the initial grouping on page 2 of the office Action although claim 5 was discussed in the first group on page 3 of the Office Action. Applicant believes that the Yohanan patent number should have been 6,072,491 (as listed in the cited references) and that claim 5 should also have been included in this initial group. Applicant herein responds to the above-identified Office Actions using the above-noted corrections. Also, in the above-referenced Office Action, claim 17 was rejected under 35 USC 102(e) as being anticipated by Bertram (US Patent 6,049,812), and claims 3-4 were rejected under 35 USC 103(a) as being unpatentable over Yohanan in view of Bertram.

The above noted rejections are respectfully traversed. However, in order to further the prosecution of the present application, and without waiving any of applicant's rights to argue the allowability of the originally presented claims in a subsequent appeal or other proceeding in the event that the Examiner does not concur that the present amendment places the application in condition for allowance, applicant has herein amended and clarified the claims to place them in condition for allowance over the cited references.

It is noted that the present application includes claims 1-17 with claims 1, 9 and 17 being independent claims, and claims 2-8

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being ultimately dependent from claim 1 and claims 10-16 being ultimately dependent from claim 9.

Independent claims 1, 9 and 17 have herein been amended to clarify that, in accordance with the present invention, a copy of a favorites file is displayed to a user together with a virtual history file area on the display screen, and the user is enabled to select from items in the favorites file and insert those selected items into the displayed virtual history file, and the newly created virtual history file is then inserted into the browser history file so that the user can use the back and forward arrows to move through the amended history file. This methodology enables a user to avoid repeating a history path that may include one or more sites which were not relevant to a specific subject and, instead, move through the modified history file which only includes files that were considered relevant to the user and which were placed in order through the creation of the virtual history file. By inserting the virtual history file or listing into the browser history file, the user is enabled to move through the customized history listing (which includes the virtual history file created by the user) using only the back and forward arrows on the browser.

Claims 7 and 15 have herein been cancelled with the substance of those claims being included in one or more of the remaining claims.

The Yohanan reference discloses a favorites list using icons but does not disclose, teach or even suggest creating a virtual history file from the favorites file and inserting the virtual history file into the browser history file as disclosed and claimed by the applicant. The system of Yohanan is unable to achieve the beneficial results which are enabled by the present

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invention as set forth in the claims as herein amended.

Bertram provides a system that enables a browser to maintain multiple concurrently active URLs. Bertram does not however disclose, teach or even suggest displaying a copy of a favorites list together with a virtual history file and enabling a user to move items from the displayed favorites list to the displayed virtual history list and inserting the virtual history file into the browser history file as disclosed and claimed by the applicant. The system of Bertram is also unable to achieve the beneficial results which are enabled by the present invention as set forth in the claims as herein amended.

Thus, since neither Yohanan nor Bertram discloses, teaches or even suggests displaying a copy of a favorites list together with a virtual history file and enabling a user to move items from the displayed favorites list to the displayed virtual history list and inserting the virtual history file into the browser history file as disclosed and claimed by the applicant, it is believed that independent claims 1 and 9, as herein amended, are allowable under 35 USC 102(e) over Yohanan and that claim 17, as herein amended, is allowable under 35 USC 102(e) over Bertram. Further, since all of the remaining claims ultimately depend from and include all of the limitations of one of the independent claims 1 or 9, in addition to even further limitations as set forth in the individual dependent claims themselves, it is believed that dependent claims 2, 6, 8-14 and 16 are also allowable under 35 USC 102(e) over Yohanan or Bertram.

With regard to the rejections of claims 3 and 4 under 35 USC 103(a) as being unpatentable over Yohanan in view of Bertram, it is believed that, as hereinbefore noted, neither Yohanan nor Bertram, nor even a combination of the two references, discloses

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or suggests displaying a copy of a favorites list together with a virtual history file and enabling a user to move items from the displayed favorites list to the displayed virtual history list and inserting the virtual history file into the browser history file, as recited in claims 3 and 4 through dependence from claims 2 and 1. There is no suggestion in either reference that it could be combined with the other reference in any manner to render the present invention obvious. Thus, it is believed that claims 3 and 4 are allowable under 35 USC 103(a) over Yohanan in view of Bertram.

Claims 7 and 15 have herein been cancelled without prejudice.

It should be noted that applicant is claiming only that the **total combination** of elements **and relationships** as recited in the claims as herein amended, is neither anticipated nor rendered obvious by the cited references individually or in combination. Applicant is aware the individual elements of any claim can be isolated, and, when standing alone, those elements can be found in existing references. The similarity of various pieces and parts of the references as noted on pages 2-6 of the above-identified Office Action have been noted but it is believed that there is no suggestion or nexus among the references to anticipate or even suggest the total combination of elements and relationships as recited in the claims as herein amended. Where there is no teaching or suggestion in any of the references for the **specific total combination** of elements **and relationships** among those elements, as claimed by an applicant, it is submitted to be inappropriate to search the prior art using applicant's own disclosure as a recipe, to find piecemeal elements in prior art references for individual claimed elements, and then to combine those references in a manner, not shown or suggested by any of the references, but rather as disclosed only by the applicant, in

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order to reject applicant's own claims.

Thus, it is submitted that claims 1-6, 8-14 and 16-17, as herein presented, are believed to be in condition for allowance, an early notice of which is hereby requested. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting the allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below. The Examiner's attention to this matter is greatly appreciated.

Respectfully submitted,

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